Docket No.: NY-LUD 5253-US5-DIV (09885911)
(PATENT)

Response to Non-Final Office Action
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.
Dated: 3/26/09 Signature: Fani Malikouzakis
(Fani Malikouzakis)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thierry Boon-Falleur et al.

Application No.: 08/819,669 Confirmation No.: 1995

Filed: March 17, 1997 Art Unit: 1644

For: TUMOR REJECTION, ANTIGEN PRECURSORS, TUMOR REJECTION ANTIGEN S AND USES THEREOF Examiner: P. Gambel

DECLARATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Norman D. Hanson hereby declares as follows:

1. He is the attorney in charge of the prosecution of the subject patent application.

2. He has conferred with relevant officials of the assignee of this application prior to setting forth this Declaration;

3. The inventions set forth in the application and in U.S. Patent No. 5,843,448, were made by inventors who were part of a joint research collaboration;

4. The claimed invention was made as a result of activities that were and are within the scope of the joint research collaboration.

5. The joint research collaboration was in place no later than the filing of the continuation-in-part application 190,411 (February 1, 1994), which eventually resulted in the issuance of a patent on a divisional application, i.e., U.S. Patent No. 5,843,448.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

March 26, 2009
Date

Norman D. Hanson, Reg. No. 30,946

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons of record.

Applicant's submission of a duplicate amendment, faxed 08/18/2009, is acknowledged.

Claims 183-191 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,843,448 (see 892, mailed 03/28/2001) for the reasons of record.

The Terminal Disclaimer over U.S. Patent No. 5,843,448, filed 07/13/2009, has been DISapproved for the following reasons.

While it is acknowledged that the Terminal Disclaimer, filed 07/13/2009, has incorporated the "not separately enforced" language of 37 CFR 1.321(d)(3) with respect to reliance upon a joint research agreement,
this Terminal Disclaimer still indicates that the instant application is commonly owned with U.S. Patent No. 5,843,448.

This stands in contrast to the record of the instant application.

In the Petition To Withdrawn Terminal Disclaimer, filed 05/02/2008, applicant noted the following facts.

"On December 6, 2006, the Examiner rejected the claims of this application on double patenting grounds, in view of U.S. Patent No. 5,843,448. The '448 patent issued with the incorrect assignees on its face. The record of its prosecution indicates, however, that the patent was co-owned: As such an obviousness-type double patenting rejection, and a terminal disclaimer are not appropriate. Please see the assignment documents from the parent application, i.e., U.S. Patent No. 5,541,104, indicating that them are two assignees, one of whom (Cornell Research Foundation, Inc), is NOT an assignee of the current application. In short, co-ownership does not exist."

In view of the foregoing, it is requested that the Terminal Disclaimer filed over U.S. Patent No. 5,843,448, be WITHDRAWN.

It is noted that the Petition to Withdraw the Terminal Disclaimer, filed 12/12/2006, was granted and mailed on 07/21/2008.

As noted previously, while a terminal disclaimer is not proper between this application and U.S. Patent No. 5,843,448, an obviousness-type double patenting rejection is still deemed proper. An obvious-type double patenting rejection is proper when there is at least one common inventor, even if there is no common ownership. For example, see Chart II-B in MPEP 804 (follow the center path). Establishing a lack of common ownership removes the option of overcoming the obviousness-type double patenting rejection via a terminal disclaimer, but it does not overcome the obviousness-type double patenting rejection.

As noted previously, given that the reference (U.S. Patent) and the pending application have the SAME effective filing / priority date; the reference does not fall within the scope of 35 USC 103(c)(1), since the U.S. Patent is NOT available under 102(e).

Therefore, the nonstatutory double patenting rejection between the instant application and U.S. Patent No. 5,843,448 cannot be overcome by a terminal disclaimer citing the provision of 37 CFR 1.321(d)(3). That is another reasons the terminal disclaimer has been disapproved.

The terminal disclaimer filed on 07/13/2009, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,843,448 has been reviewed and has not been accepted.

With respect to ODP with U.S. Patent No. 7,495,074; it is noted that applicant still has not addressed the following issue concerning double patenting with commonly assigned U.S. Patent No. 7,495,074.

Applicant should address the following.

Claims 183-191 and newly added 192-195 are directed to an invention not patentably distinct from claims 1-8 of commonly assigned U.S. Patent No. 7,495,074 for the reasons of record.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.
A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Applicant should clearly indicate the ownership of the instant application and that of U.S. Patent No. 7,395,074. While applicant asserts that there is common ownership, it remains unclear whether the instant application and the patent are totally commonly owned, rather than having an owner in common;

given the record of the instant application where USPTO records are inconsistent with applicant's assertions about ownership or the inconsistency between applicant's statement in the Terminal Disclaimer filed 07/13/2009 about common ownership and applicant's previous Petition to Withdraw the Terminal Disclaimer, filed 12/12/2006.

With respect to applicant's comments about the ODP rejection itself, the claims of U.S. Patent No. 7,495,074 drawn to MAGE-4 tumor rejection antigens anticipated the instant claims.